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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: Kevin Donovan	Examiner: Dohm Chankong
Application No.: 09/385,802	Group Art Unit: 2152
Filed: August 30, 1999	Attorney Docket No.: 4031/I 15719US00
For: Universal Instant Messaging System For The Internet	

SECOND DECLARATION OF PROFESSOR AVIEL RUBIN UNDER 37 CFR § 1.132

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Chankong:

1. I, Aviel Rubin, declare as follows:

2. I am the Aviel Rubin who provided a prior Declaration in this matter, signed 10/11/06.

3. I hold B.S., M.S., and Ph.D. degrees in Computer Science from the University of Michigan, awarded in 1989, 1991 and 1994 respectively.

4. I am a professor of Computer Science in the Whiting School of Engineering at The John Hopkins University, where I have been a faculty member since 2003. Additionally, I am Technical Director of The John Hopkins University Information Security Institute. Prior to 2002, I was an Adjunct Professor at New York University and a Security researcher at AT&T Labs.

5. I have been retained to provide this declaration as to patent application number 09/385,802, "Universal Instant Messaging System For The Internet," herein referred to as "Donovan". I have reviewed the above-identified patent application, the Office Action dated January 9, 2007 and cited references, and the claim amendment filed July 9, 2007.

6. On Page 3 of the Office Action of January 9, 2007, the Examiner asserts that claims 16-20, 22, 103, and 105-151 fail to include essential subject matter. Of these claims, claims 16, 108, 112, 113, 114, 118, and 128 are independent claims. Claims 16, 108, 112, 113, 114, and 118 are all method claims while claim 128 is a system claim.

7. The Examiner generally asserts at page 3 of the Office Action that "the instant messaging server, an instant messaging database, and authorization database and a profile database are all critical or essential to the practice of the invention, but not included in the claims."

8. However, claim 16 recites a method, not an apparatus or system, for performing the invention and properly recites in detail the relevant procedural steps for carrying out the invention. The Examiner's insistence on the recitation of specific hardware structural elements to perform the recited method steps does not conform with the technological reality that the procedural steps recited in claim 16 and other method claims may be performed by hardware other than the specific devices that the Examiner mentions. To insist that the invention be limited to specific hardware elements, especially in a method claim, ignores the technological reality that similar procedural steps may often be performed by differing systems. Thus, the specific hardware components recited by the Examiner are not essential or critical to the procedural operation of the invention as recited in method claim 16 and the other method claims 108, 112, 113, 114, and 118.

9. With regard to system claim 128, claim 128 is directed to a different invention than previously discussed claims. For example, although claim 16 recites establishing an instant messaging session between users in two separate realms and encrypting an instant message during the instant messaging session, claim 128 recites an encrypted instant messaging session, but does not require that the participants in the instant messaging session be in two separate realms. However, the Examiner apparently asserts that specific hardware elements that are used to implement the multi-realm aspect, rather than the encryption aspect, must also be included in a claim that is not directed toward the multi-realm aspect. Further, although the Examiner simply asserts that "Applicant's present invention would not be possible without the various servers and databases as illustrated in Figure 1 and described in detail in the specification and therefore should be included in the claims," if the invention is viewed as simply providing an encrypted instant messaging session, as recited in claim 128, then it would appear plain that not every last one of the "various servers and databases as illustrated in Figure 1" is essential to the operation. Thus, in broad terms, claim 16 is directed to encrypted, multi-realm instant messaging, while claim 128 is directed to encrypted instant messaging without the multi-realm requirement. An assertion that claim 128 must include specific hardware elements used to implement multi-realm instant messaging, in the absence of relevant prior art, is improper.

10. Next, at Page 3 of the Office Action, the Examiner contends that claims 16-20, 22, 103, and 105-151 fail to comply with the enablement standard because undue experimentation is required. The Examiner does recognize that the test is not whether any experimentation is necessary, but whether the experimentation is undue.

11. With regard to the level of knowledge of the persons of skill in the art to be employed when determining enablement, I have been directed to section 2164 of the Manual of Patent Examining Procedure (MPEP), Eighth Edition, Revision 5, August 2006 which recites:

> In computer applications, it is not unusual for the claimed invention to involve two areas of prior art or more than one technology, e.g., an appropriately programmed computer and an area of application of said computer. White Consol. Indus. v. Vega Servo- Control, Inc., 214 USPQ 796, 821 (S.D.Mich. 1982). In regard to the "skilled in the art" standard, in cases involving both the art of computer programming, and another technology, the examiner must recognize that the knowledge of persons skilled in both technologies is the appropriate criteria for determining sufficiency. See In re Naquin, 398 F.2d 863, 158 USPQ 317 (CCPA 1968); In re Brown, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); White Consol. Indus., 214 USPQ at 822, aff'd on related grounds, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983). (Emphasis Added)

Consequently, when a claim recites both instant messaging and encryption, as does claim 16, for example, the relevant person of skill for consideration of enablement is person of skill in both instant messaging and encryption, not just instant messaging.

12. The contention specifically raised by the Examiner at Page 4 of the Office Action at section (i) is recited as "Here, Applicant's specification fails the test of enablement because there would be undue experimentation necessary to implement encryption over multiple realms." However, paragraph 35 of the specification recites:

> If in step 122 Ted accepts the connection request or if the SP 18 did not require that a message be sent to Ted, thereby skipping step 122, then in step 126 server 18 sends a message to Bill indicating Ted's current IP address. If necessary, this preliminary exchange may include an encryption key to allow the communications between Ted and Bill to be encrypted using any standard security protocol. (Emphasis added).

Thus, once the connection has been established, any of the several standard encryption key based security protocols (that were well known at the time of filing in August of 1999) may be employed to implement the encryption over multiple realms. Here, not only is there no undue experimentation necessary, the specification explicitly recites that any of the several, well-known security protocols may be employed. One skilled in the art of encryption would certainly have been aware of many if not all of the several encryption key based security protocols that were available in August of 1999.

13. Thus, the experimentation required for one skilled in the art to implement only the encryption aspect recited in claim 16 includes: 1) selection of one of the available encryption protocols, 2) setting the format for passing data to the encryption protocol for encryption, and 3) at the receive end, after the data has been decrypted by the encryption protocol, configuring the instant messaging application to receive data in the particular data format passed by the encryption protocol. These elements were well within the skill of one of ordinary skill in the art at the time of filing. Consequently, I must respectfully disagree with the Examiner's assertion that implementing encryption over multiple realms requires undue experimentation for a person skilled in the art.

14. Further, I have been directed to section 2164.06(I) of the Manual of Patent Examining Procedure (MPEP), Eighth Edition, Revision 5, August 2006, which discusses *United States v. Telectronics, Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989), wherein the Federal Circuit found that experimentation requiring $50,000 and 6-12 months was not undue experimentation and the claims were thus enabled. A comparison of the significant effort in this case that was still found to be enabled with the substantially lesser amount of effort required to implement in the present situation further underscores the determination that the Examiner's assertion that implementing encryption over multiple realms requires undue experimentation for a person skilled in the art is unreasonable.

15. Further, it is my understanding that the test for obviousness is not identical to the test for determining whether a claim is non-enabled because undue experimentation is required for several reasons. More specifically, it is my understanding that when attempting to determine enablement for a claim, we consider a person of skill in the art that has full knowledge of the prior art, the specification, and the claim, and then we inquire as to whether that person can construct a functional system according to the claim without undue experimentation. Conversely, when determining non-obviousness, it is my understanding that we consider a person of skill in the art that has full knowledge of the prior art, but does not have any knowledge of the present specification or claims. Thus, when determining enablement, the person of skill has the advantage of the specification and claims when constructing the system.

Further, arguments that are properly raised against a finding of obviousness such as a "teaching away" in the prior art or in the common knowledge of the field are not applicable to a determination of enablement because the "teaching away" attacks the motivation of two or more elements to be combined, while conversely when determining enablement we start with the premise that the two or more elements have already been combined as recited in the claim and we are merely trying to construct a working embodiment.

Further, when determining the level of skill in the art for determining obviousness, the person has merely the knowledge of the prior art. Conversely, when determining the person skilled in the art for enablement purposes, the person of skill must be a person skilled in both (or all) of the technologies recited in the claim, whether or not that person actually existed, outside of the inventor, at the time of filing.

16. Consequently, because of the differing standards for enablement and obviousness determinations, taking comments that were made in support of a "teaching away" non-obviousness argument out of context and using them to attempt to support a non-enablement rejection is improper and applies the wrong standard. For example, on Pages 5 and 6 of the Office Action, the Examiner cites language from my previous Declaration that was recited as evidence of "teaching away" or lack of motivation to combine and attempts to use the language to support an assertion of lack of enablement. This is improper and applies the wrong standard because, as discussed above, arguments with regard to "teaching away" are not applicable to a determination of enablement for the simple reason that "teaching away" is ignored when determining enablement. Instead, the enablement determination starts with the premise that the claim elements have already been combined – it does not question whether there was a reason to combine them.

17. Further, my statement in paragraph 10 of my previous Declaration that "Encryption would not have been a common skill for an instant messaging programmer to have had in 1999," while useful for a determination of non-obviousness, is also irrelevant to a determination of enablement because, for a claim reciting both instant messaging and encryption, the enablement determination is required to apply a person of skill in both instant messaging and encryption, whether or not such a person existed.

18. Finally, I would like to clarify my statement in my prior Declaration that "I have been retained to give my opinion..." so as to make it clear that, while consulting rates have been and are being charged, I have never had a vested interest in the outcome of this patent application or any related matter.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and believe are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date: August 12, 2007

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